Supreme Court, U.S.
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IN THE

Supreme Court Of The United States

INTERMATIC INCORPORATED,

Petitioner,

V.

THE LAMSON & SESSIONS CO.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SUPPLEMENTAL APPENDIX

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34 pgs

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED,	)	
Plaintiff,	)	
	)	No. 99 C 50410
v.	)	
LAMSON & SESSIONS CO.,	)	
Defendant.	)	

MEMORANDUM OPINION AND ORDER

Introduction

Plaintiff Intermatic Inc. ("Intermatic") has filed a second suit against Lamson & Sessions Co. ("Lamson"), alleging infringement of Intermatic's U.S. Pat. 5,280,135 ("the '135 patent," which the parties also refer to as "the Bentsen patent"). This court has jurisdiction over the dispute pursuant to 28 U.S.C. § 1338, and venue is proper pursuant to 28 U.S.C. § 1400(b). Currently before the court are several motions: Intermatic's motion to dismiss Lamson's affirmative defense and counterclaim of infringement, filed pursuant to Fed.R.Civ.P. 12(b)(6); Lamson's motion for judgment on the pleadings pursuant to Rule 12(c) as to Intermatic's claim of infringement; and, Lamson's motion for summary judgment, filed pursuant to Fed.R.Civ.P. 56, as to noninfringement of the '135 patent.

Discussion

A. Intermatic's Motion to Dismiss Lamson's Validity Challenge

The parties in this lawsuit are no strangers to each other or the court, having extensively litigated the '135 patent before this court in *Intermatic v. Lamson & Sessions*, No. 94 C 50295, currently pending before the Federal Circuit Court of Appeals. In case No. 94 C 50295, on September 17, 1999, a jury confirmed the validity under 35 U.S.C. § 103 of all independent claims of the '135 patent. Although the jury found three dependent claims (claims 6, 9 and 11) were invalid, this court found as a matter of law that dependent claims 6, 9 and 11 are valid per Order dated October 20, 1999. This court further found the facts overwhelmingly supported a finding that independent claims 1, 12 and 14 are valid.

Intermatic is correct in that Lamson cannot again attack the validity of the '135 patent in this case. *See Blonder Tongue Lab Inc. v. University of Ill. Found.*, 402 U.S. 313 (1971); *Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.*, 170 F.3d 1373, 1379 (Fed. Cir. 1999). Lamson had a full and fair opportunity to litigate the validity of the '135 patent in Case No. 94 C 50295. Lamson argues the preclusive effect of the prior lawsuit does not extend to invalidity defenses to claims not litigated in the prior action. (Def. Resp., p. 2) The court rejects Lamson's argument. The claims not at issue in the previous lawsuit are not at issue in this case. (Plaintiff Reply, p. 1) Thus, Lamson has no reasonable apprehension that new claims are at issue here. *See Grain Processing Corp. v. American Maize Prod. Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988). In addition, that Case No. 94 C 50295 is on appeal has no effect on the finality of the court's and jury's findings regarding the validity of the '135 patent.

Mylan, 170 F.3d at 1381; *Dana Corp. v. NOK, Inc.*, 882 F.2d 505, 507 (Fed. Cir. 1989). Thus, Intermatic's motion to dismiss Lamson's affirmative defense and counterclaim of validity is granted.

B. Lamson's Motion for Summary Judgment

Lamson argues its redesigned "ribless" product does not literally infringe on the '135 patent as a matter of law, based on the court's previous rulings in Case No. 94 C 50295. The court agrees. In that case, per Order dated March 30, 1999, the court ruled as a matter of law that Lamson's in use weatherproof outlet covers with "ribbed" inserts did not literally infringe any of the pertinent claims of the '135 patent. It stands to reason that the "ribless" product does not literally infringe the '135 patent for the same reasons.

In its March 30, 1999 Order, this court also held it was for the jury to decide whether Lamson's "ribbed" product infringed under the doctrine of equivalents. Specifically, this court stated:

> [A]t issue is whether Lamson's inserts have an element that is equivalent to Intermatic's insert 'within the aperture.' As stated above, Lamson's inserts in each of its products have a structure called 'ribs' or 'ribbing.' This ribbing extends into the aperture of the base and performs mounting and locating functions.

Intermatic v. Lamson & Sessions, No. 94 C 50295, Order dated Mar. 30, 1999, at 10.

As this passage shows, the predominant reason the 94 C 50295 case proceeded to the jury stage was because of

the ribbing on the back of Lamson's inserts which extended into the aperture. Absent such ribbing and in light of the court's interpretations of the '135 patent following the *Markman* hearing, *see* order dated Feb. 9, 1999, Lamson's "ribless" product does not infringe under the doctrine of equivalents.

Intermatic argues a question of fact exists as to whether the "ribless" product infringes because when installed, the "ribless" insert flexes into the aperture. The court rejects Intermatic's argument. It is undisputed the Examiner rejected original claim 14 of the '135 patent as obvious over Leong in view of Bentsen. (LR56.1(a) ¶ 19) Intermatic then amended claim 14 to include the limitation that the insert be "accommodated within the aperture." (*Id.* ¶ 22) As Lamson notes, the thin, flexible insert plates of Bentsen are bendable in the middle, "said inserts being free at their mid portions to bend inwardly..." Def. Reply, Exh. A, Bentsen patent, col. 4, 11. 26-35. This description shows the Bentsen insert could bow into the aperture. Thus, in amending claim 14, Intermatic relinquished the subject matter of whether a thin, flexible insert, capable of bowing into the aperture, is an equivalent of an insert "within the aperture." In short, prosecution history estoppel precludes Intermatic's argument. *See Haynes Int'l, Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1577 78 (Fed. Cir. 1993).

C. Lamson's Rule 12(c) Motion

In light of the court's ruling regarding Lamson's motion for summary judgment, its Rule 12 (c) motion is denied as moot.

Conclusion

For the reasons set forth above, Intermatic's motion to dismiss Lamson's validity challenge is granted, Lamson's motion for summary judgment is granted, and Lamson's Rule 12(c) motion is denied as moot. This cause is hereby dismissed in its entirety.

ENTER:

/s/
PHILIP G. REINHARD, JUDGE
UNITED STATES DISTRICT COURT

DATED: September 28, 2000

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	No. 94 C 50295
	)	
LAMSON & SESSIONS CO.,	)	
	)	
Defendant.	)	

JUDGMENT IN A CIVIL CASE

Jury Verdict. This action came before the Court for a trial jury. The issues have been tried and the jury rendered its verdict.

Decision by Court. This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS HEREBY ORDERED AND ADJUDGED that plaintiff, Intermatic, Inc's, motion for judgment as a matter of law that Lamson does not infringe claim 19 is granted. The court enters judgment in favor of Lamson & Sessions Company and against Intermatic, Inc. only to the extent that Lamson & Sessions Company does not infringe claim 19. Plaintiff's oral motion for judgment as a matter of law on validity defense is denied. (See minute order of September 16, 1999.)

As to validity, the court enters judgment in favor of plaintiff, Intermatic, Inc., on claims 1, 4, 5, 8, 10, 12, 14, 15, and 18 and against defendant, Lamson & Sessions Company, and the court enters judgment in favor of defendant, Lamson & Sessions Company, on claims 6, 9, and 11 and against plaintiff, Intermatic, Inc. As to infringement on the original double gang outlet covers made by Lamson, the court enters judgment in favor of plaintiff, Intermatic, Inc., on claims 1, 3, 4, 6, 7, 8, 9, 11, 12, 14, 15, 16, 17, and 18 and against defendant, Lamson & Sessions Company, and the court enters judgment in favor of defendant, Lamson & Sessions Company, on claims 5 and 16 and against plaintiff, Intermatic Inc. As to infringement on the redesigned double gang outlet covers made by Lamson, the court enters judgment in favor of plaintiff, Intermatic, Inc., on claims 1, 3, 4, 6, 7, 8, 9, 10, 11, 12, 14, 15, 17, and 18 and against defendant, Lamson & Sessions Company, and the court enters judgment in favor of defendant, Lamson & Sessions Company, on claims 5 and 16 and against plaintiff, Intermatic, Inc. As to infringement on the single gang outlet covers made by Lamson, the court enters judgment in favor of plaintiff, Intermatic, Inc., on claims 1, 4, 5, 6, 8, 9, 10, 11, 12, 14, 15, and 18 and against defendant, Lamson & Sessions. (See minute order of September 17, 1999.)

The court enters judgment as to damages for lost profits and price erosion in favor of plaintiff, Intermatic, Inc. and against defendant, Lamson & Sessions, Co., in the amount of $12,500,000.00 and jury verdict finding defendant, Lamson & Sessions, Co.'s, infringement was willful. (See minute order of September 22, 1999.)

Plaintiff's motion for prejudgment interest, enhanced damages and attorney fees is granted in part and denied in

part. The court awards prejudgment interest at the statutory rate of 5 percent beginning September 9, 1994 through October 20, 1999. Thereafter, Intermatic is entitled to post judgment interest at the United States Treasury bill rate compounded. The court denies plaintiff's motion for enhanced damages and attorney fees. (See minute order of October 20, 1999.)

Plaintiff's motion for judgment as a matter of law that claims 6, 9, and 11 are not invalid is granted and defendant's combined motion for judgment as a matter of law and for a new trial is denied in its entirety. Judgment is entered for Intermatic on the jury verdict of infringement and the court enters judgment for Intermatic on validity. (See minute order of October 20, 1999.)

All orders in this case are now final and appealable.

Michael W. Dobbins
Clerk of the Court

Dated: 10/20/1999

_____
Susan Wessman, Deputy Clerk

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED, Plaintiff, v. LAMSON & SESSIONS CO., Defendant.	No. 94-C-50295 Judge Philip G. Reinhard Magistrate Judge P. Michael Mahoney

For the reasons stated on the reverse, Lamson's second motion in limine, to exclude opinion testimony of lost profits based on alleged diminished business value, is granted.

Date: 9/20/99 /s/ (Philip G. Reinhard)

ORDER

Under Federal Rule of Evidence 702, the court has a gatekeeping function, that of ensuring an expert's testimony rests on a reliable foundation and is relevant to the task at hand. *Kumho Tire Co., Ltd. v. Carmichael*, - U.S. , 119 S. Ct. 1167, 1171 (1999); *Daubert v. Merrell Dow Pharm.*, 509 U.S. 579 (1993). In exercising its gate-keeping function, the court considers the following factors: whether the theory can be (and has been) tested; whether it has been

subjected to peer review and publication; whether there is a high known or potential rate of error and whether there are standards controlling the theory; and, whether the theory enjoys general acceptance in the relevant community. *Kumho Tire*, 119 S. Ct. at 1175. These factors do not constitute a definitive checklist, as the test of reliability is flexible. Id. at 1171.

Here, the court does not doubt the qualifications of Intermatic's expert, Paul Duggan. Nor does the court question the validity of using a price/earnings (P/E) ratio in valuing a company, or that a company's diminished business value can be a form of damages under certain circumstances. However, the court finds Intermatic has not established that Duggan's theory regarding Intermatic's alleged diminished business value rests on a reliable foundation. In calculating Intermatic's alleged diminished business value, Duggan uses Lamson's P/E ratio. Plaintiff's own submissions define a P/E ratio as the relationship between the market price of the company's stock and its *net income.* (Pl. Exh. 2(B), *Guide to Business Valuations, p. 604.6)* Yet, the product at issue which allegedly caused harm to Intermatic constitutes only a small percentage of each parties' sales (one percent of Lamson's and three percent of Intermatic's). Duggan has failed to establish any connection between Lamson's P/E ratio and the alleged harm one of its product lines, constituting only one percent of its sales, caused to Intermatic.

Because of this lack of connection, Duggan's theory does not meet any of the factors set forth in *Kumho Tire*. For example, Duggan's theory does not appear to hold up under testing. According to Lamson's expert, if Lamson's 1997 data were used instead of its 1996 data, Intermatic's

claim based on Duggan's theory would change to a negative $38.9 million. (Def. Exh. C, p. 26) Duggan himself refused to speculate as to the monetary amount of Intermatic's alleged diminished business value under his theory if Lamson did not have a profit in 1997. (Def. Second Mot. in Limine, p. 11) In addition, contrary to Intermatic's assertions, Duggan's theory has not been subjected to peer review and publications. The articles and book excerpts Intermatic has submitted generally discuss P/E ratios and diminished business value as a form of damages, but do not discuss Duggan's particular theory using these concepts applied to the facts here. Although Duggan asserts he provided similar testimony in *Flint Ink Corp. v. Brower* (E.D. Mich.), he has not provided the court with his testimony, nor is there any published opinion discussing the admissibility of his testimony. Moreover, the court has not located any other case in which an expert has asserted a damages theory similar to Duggan's in a similar contest. In short, an analysis of the general guidelines set forth in *Kumho Tire* shows Duggan's theory regarding damages in the form of Intermatic's alleged diminished business value based on Lamson's P/E ratio is inadmissible. Likewise, if Duggan's discounted future cash flow approach also depends on an inverse of Lamson's P/E ratio (Duggan's declaration is not clear on this point), it would be inadmissible for the same reasons.

Because Duggan's testimony does not meet the standard for admissibility under Rule 702, Intermatic's suggested alternatives of reserving future damages for the court, treating the jury's damages verdict as advisory, or reducing the jury's verdict are unacceptable.

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED, Plaintiff, v. LAMSON & SESSIONS CO., Defendant.	Civil Action No. 94-C-50295 Judge Philip G. Reinhard Magistrate Judge P. Michael Mahoney

For the reasons stated on the reverse, plaintiff Intermatic's motion in limine to preclude evidence of certain hypothetical post-trial activities is granted in part and denied in part.

Date: 8/27/99 /s/ (Philip G. Reinhard)

ORDER

This order addresses Intermatic Inc.'s ("Intermatic") motion in limine to preclude evidence of certain hypothetical post-trial activities. Specifically, Intermatic argues Lamson should be precluded from telling the jury: (1) about the possibility of an injunction; and, (2) that Lamson may sell a redesigned, non-accused product following trial.

Regarding the injunction, the court agrees with Intermatic. Whether the court awards injunctive relief (assuming Lamson is found liable) is irrelevant to any issues the jury will be deciding. *United States Football League v. National Football League*, No. 84 Civ. 7484 (PKL), 1986 U.S. Dist. Lexis 24088, at *5-7 (S.D.N.Y. June 17, 1986). Lamson argues that if Intermatic is allowed to present expert testimony regarding future lost profits and future price erosion in the form of "diminished business value," Lamson should be able to present evidence of a possible injunction. Given the court's decision to bifurcate the issues and its expressed skepticism of the admissibility of such testimony, the court reserves this issue until a later date.

Regarding Lamson's redesigned products, one of which is a "ribless" product, Lamson argues such evidence will assist the trier of fact in assessing the function of the ribs. The court disagrees. Adding a new, "ribless" product to the mix will unnecessarily confuse the jury in its task of determining what products are at issue and whether these accused products infringe. Lamson argues that allowing the jury to compare the "ribless" product with the "ribbed" product will assist the jury in understanding the function of the ribs. Lamson can accomplish this other ways.

Lamson also argues that its "ribless" product and its proposed redesigns in 1995 are relevant to the issues of willfulness and damages. It is not clear whether Intermatic is claiming that these redesigns also infringe its patent. Given that the court has bifurcated the trial, it reserves the issue of whether Lamson's '95 and '99 redesigns are admissible in the second phase of the trial and will revisit the issue at that time, if necessary.

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED,	)	
Plaintiff,	)	
	)	No. 94 C 50295
v.	)	
LAMSON & SESSIONS CO.,	)	
Defendant.	)	

MEMORANDUM OPINION AND ORDER

Plaintiff Intermatic, Inc. ("Intermatic") filed suit against defendant Lamson & Sessions Co. ("Lamson"), alleging patent infringement concerning its outdoor electrical outlet covers. Jurisdiction arises under 28 U.S.C. § 1338(a), and venue is proper pursuant to 28 U.S.C. § 1400(b). Several motions are currently pending before the court. This opinion addresses Lamson's motion for summary judgment, filed pursuant to Fed.R.Civ.P. 56, on the issue of non infringement

PRELIMINARY MATTERS

Local Rule 12M and 12N statements of fact are to contain facts, not legal argument. To the extent that legal argument is contained in a party's statement of fact, or response thereto, it will be disregarded by this court. Furthermore, under Local Rules 12M and 12N, all facts and denials must be supported by specific reference to the

record. Unsupported allegations of fact will not be considered, and unsupported responses to properly supported allegations of fact will be deemed an admission of the opposing party's corresponding paragraph pursuant to Local Rules 12M and 12N.

Furthermore, Lamson has repeatedly interjected arguments and allegations concerning products not included in this infringement suit, resulting in an unnecessary clouding of the issues. As the court has yet to understand the relevance of these additional products, all such allegations and arguments related to such products will not be considered by the court.

FACTS[1]

Intermatic owns U.S. Letters Patent No. 5,280,135 (the '135 patent) directed to an outdoor electrical outlet cover. Intermatic and Lamson both manufacture weather protective/ resistant covers for outdoor electrical outlets. Following the allowance of the '135 patent application, Intermatic filed a complaint against Lamson alleging infringement of the '135 patent, asserting that four of Lamson's basic product designs infringe on Intermatic's patent: the vertical single gang - E9UV(G,W,C);[2] the deep

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[1] The facts are taken from the parties' respective statements of material fact submitted pursuant to Local Rules 12M and 12N, the *Markman* claim interpretation order (referred to hereinafter as the "*Markman* order"), and correspondence dated February 22, 1999, and February 24, 1999, from the attorneys for each party.

[2] The code "(G,W,C)" refers to the product colors gray, white and clear, respectively.

vertical single gang - E9UDV(G,W,C); the double gang - E9U2(G,W,C)[3]; and the horizontal single gang - E9UH(G,W,C). All of Lamson's allegedly infringing products have (1) a base with side walls and a back wall, (2) a housing hinged to the base, and (3) either one or two insert plates. Lamson's insert plates have structure which depends from the rear wall of the insert, referred to as "ribs" or "ribbing" by the parties.

Intermatic's patent has nineteen claims, with claims 1, 3 12, and 14 19 originally at issue in this case. During the course of litigation, the patent was reexamined, resulting in the modification of claim 14. Intermatic alleges that Lamson's electrical outlet cover infringes on three independent claims, as well as several dependent claims.[4] The currently disputed independent claims are set forth seriatim:

1. An outdoor weatherproof protective electrical outlet cover adapted to be attached in weatherproof connection to an electrical outlet comprising:

   (a) a base plate adapted to be attached in weather-proof connection with the electrical

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[3] This product number refers to the product Lamson is currently producing. Lamson redesigned the originally named product after the onset of this litigation. It is undisputed the original double gang outlet cover was capable of horizontal and vertical positioning of the inserts.

[4] Intermatic originally alleged that Lamson's products also infringed on claim 19, but has since withdrawn this argument in light of the court's *Markman* Order.

outlet, the base plate having an aperture of sufficient size to accommodate the electrical outlet positioned in a first orientation and a second orientation wherein only one electrical outlet orientation can be accommodated at a given time;

(b) an insert sized an [sic] adapted to fit within the aperture of the base plate in a first orientation and a second orientation,. the insert being of sufficient size to accommodate one electrical outlet orientation;

(c) a protective housing defining a closed space enclosing the electrical outlet even with at least one electrical plug present, the protective housing adapted to be mounted to the base plate.

12. An improved outdoor electrical outlet cover comprising, a base plate fastened to a weather resistant electrical outlet housing adapted to cover an electrical outlet, the improvement comprising:

(a) a base plate adapted to be attached in weather-proof connection with the electrical outlet, the base plate having an aperture of sufficient size to accommodate an electrical outlet positioned in a first orientation and a second orientation wherein only one electrical outlet orientation can be accommodated at a given time;

(b) an insert adapted to be accommodated within the aperture of the base plate in a

first orientation and a second orientation, the insert being of sufficient size to accommodate one electrical outlet orientation;

(c) a protective housing defining a closed space enclosing the electrical outlet even with at least one electrical plug present, the protective housing adapted to be mounted to the base plate.

14. A weather resistant outlet cover for an electrical service device mounted in an electric box comprising:

(a) a base adapted to be mounted in a moisture resistant connection around the electrical box, *said base having an aperture therein;*

(b) a housing pivotally connected to the base along an upper portion thereof and adapted to provide a moisture resistant enclosure in front of the electrical service device; and

(c) an insert adapted to be [mounted] *accommodated with [sic] the aperture* in the base and further in which the insert includes at least an aperture therein conforming in size and shape to the electrical service device.[5]

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[5] This is reexamined claim 14. The bracketed information indicates language deleted from the original claim 14 and the italicized information indicates language which was added.

Lamson filed its motion for summary judgment of noninfringement on December 15, 1997. The motion, along with Intermatic's response, brought to light disputes between the parties in regard to claim construction. The court held a hearing on January 27, 1999, to construe disputed claim language. A summary of the court's interpretation of the disputed claim language, set forth in full in its *Markman* Order, is as follows:

(1) "Aperture" is limited to the hole in the base of the outlet cover and does not include the recess;

(2) The language "of sufficient size" does not mean "larger";

(3) The insert is defined as having an outer dimension conforming to or smaller than the outer dimensions of the aperture, and does not include the flange or raised ledge;

(4) The language "first orientation" and "second orientation" includes a 180 degree rotation of the insert;

(5) The reexamined claim 14 is substantially different than the original claim 14; and

(6) Depression of the "release button" of claim 19 is essential to opening the latching mechanism.

In response to the *Markman* Order, Intermatic withdrew allegations of infringement based on claim 19, and withdrew its arguments that the aperture includes the recess and that no substantial change was made to claim 14

during reexamination. Lamson withdrew arguments directed towards the orientation and size limitations of claims 1 and 12 with respect to its double gang units, but left intact the arguments concerning its single gang units.

STANDARD

Summary judgment is proper when no genuine issue of material fact exists and the moving party is entitled to judgment as a matter of law. *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1378 (Fed. Cir. 1998). Justifiable factual inferences and elements of doubt are to be resolved in favor of the non movant. *Abbott Lab. v. Novopharm Ltd.*, 104 F.3d 1305, 1307 (Fed. Cir. 1997); *Trilogy Communications, Inc. v. Times Fiber Communications, Inc.*, 109 F.3d 739, 741 (Fed. Cir. 1997).

The moving party must first establish that there are no genuine issues of material fact, and the non moving party must establish specific facts showing the existence of a genuine issue of material fact. *Phillips Petroleum Co. v. Huntsman Polymers Corp.*, 157 F.3d 866, 870 (Fed. Cir. 1998). Since Intermatic has the burden of establishing infringement at trial, Lamson must show a lack of evidentiary support for Intermatic's claim. *See id.*

ANALYSIS

Any infringement analysis entails two elements. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996). The first element is the interpretation of disputed claim language, which is a question of law. *Id.* The court resolved these issues in its Markman Order. The second element is determining whether infringement has occurred. *Id.* This step involves application of the construed claims to the allegedly infringing products to

determine whether literal infringement or infringement under the doctrine of equivalents has occurred. *See, e.g., Spectrum Int'l, Inc.*, 164 F.3d at 1380.

A claim is literally infringed when every limitation recited in the claim can be found in the accused device. *Amhil Enter. Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1562 (Fed. Cir. 1996). "If even one limitation is missing or not met as claimed, there is no literal infringement." *Mas-Hamilton Grp. v. LaGard, Inc.*, 156 F.3d 1206, 1211 (Fed. Cir. 1998). Where no literal infringement is found, an accused product might still be found to be infringing under the doctrine of equivalents if it "contain[s] elements identical or equivalent to each claimed element of the patented invention." *Warner Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, ___ U.S. ___, 117 S. Ct. 1040, 1053 (1997). The Supreme Court, in *Warner-Jenkinson*, set forth the essential framework of an equivalence analysis:

> An analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element..

Id. at 1054.

Therefore, in determining whether literal infringement or infringement under the doctrine of equivalents has occurred, each of Lamson's products must be compared to each of the '135 claims at issue.

Lamson's claim of non infringement is based on two elements of the '135 patent which it asserts are not found in its products. The first element, which Lamson calls the "specific insert" requirement, is the requirement in claims 1, 12, and 14 that the weatherproof outlet cover have an insert "within the aperture." The second element, which Lamson calls the "multiple orientation" requirement, is the requirement in independent claims 1 and 12 that the insert fit within the aperture of the base plate in a first orientation and a second orientation. The court will address each of these elements.

A. The "specific insert" requirement

In this case, claims 1, 12 and 14 require that the electrical outlet cover have either "an insert adapted to fit within the aperture of the base plate" (Claim 1), "an insert adapted to be accommodated within the aperture of the base plate" (Claim 12), or "an insert adapted to be accommodated within the aperture in the base" (reexamined claim 14, with certificate of correction). The court, in its *Markman* Order, construed the language "within the aperture" as a limitation meaning "...the insert must have an outer dimension conforming to, or smaller than, the outer dimensions of the aperture to fit *within* the aperture."

Lamson argues none of its products have an insert that fits "within the aperture" because each insert is larger than the aperture of the base of the outlet cover. The court agrees that there is no literal infringement, as the inserts of all of Lamson's products are larger than the outer dimension of the aperture and do not have an outer dimension conforming to, or smaller than, the outer dimensions of the aperture. Summary judgment of no

literal infringement is proper when no reasonable jury could find that every limitation recited in a claim is found in an accused device. *Spectrum Int'l, Inc.*, 164 F.3d at 1380. Because no reasonable jury could find that Lamson's inserts meet the limitation of "within the aperture" as construed by this court, Lamson's accused products cannot literally infringe claims 1, 12 and 14 as a matter of law.

Although literal infringement does not exist, the next step of the inquiry is whether any of Lamson's products at issue infringe under the doctrine of equivalents, a doctrine which was recently upheld in *Warner-Jenkinson*. Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is "equivalence" between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson*, 117 S. Ct. at 1045. The doctrine of equivalents is applied element by element, rather than to the invention as a whole. *Id.* at 1049.

In this case, at issue is whether Lamson's inserts have an element that is equivalent to Intermatic's insert "within the aperture." As stated above, Lamson's inserts in each of its products have a structure called "ribs" or "ribbing." This ribbing extends into the aperture of the base and performs mounting and locating functions. Lamson argues this structure cannot be equivalent to Intermatic's insert as a matter of law because of prior art. Specifically, Lamson asserts that the ribbing is the same as ribs found on a GE decorative faceplate sold many years ago and, therefore, should be considered within the public

domain.[6] The court finds that a question of fact exists as to whether the structure found on the GE faceplates: (1) is "within the aperture," and (2) has the same moisture resistance, mounting and locating functions as the ribbing structure in Lamson's inserts. In short, the court leaves to a jury the question of whether any of Lamson's inserts infringe on Intermatic's insert under the doctrine of equivalents.[7]

B. The "multiple orientation" element.

In addition to the specific insert element, claims 1 and 12 require that the inserts be accommodated in multiple orientations. Since this court held in the previous section that Lamson's products do not literally infringe on claims 1, 12 and 14 as a matter of law, the court will

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[6] The GE decorative faceplate was an embodiment of a patent (the Bensten patent) assigned to GE. The patent was considered during the reexamination, and was included in prior art used in an obviousness-type rejection that resulted in modification of claim 14. The GE product was not considered in the reexamination because it did not fall within the scope of prior art considered during a reexamination as set forth in the Manual of Patent Examining Procedure ("MPEP") § 2258. The GE product differs from the Bentsen patent in that GE's faceplate insert has structure depending from the rear wall of the insert surrounding the aperture, created for securing the faceplate to the outlet (i.e., screw holes), which is not described in the patent.

[7] Should a jury determine that Lamson's ribbing is equivalent to an insert within the aperture, the court will then address whether the equivalent structure falls within the range of equivalent as limited by prior art.

address Lamson's argument regarding the multiple orientation element under the doctrine of equivalents.

Lamson argues that its single gang units have symmetrical inserts which present the same orientation when rotated 180 degrees. According to Lamson, symmetrical inserts do not infringe because they do not meet the "first" and "second" orientation limitation of claims 1 and 12.

The *Markman* Order construed a "first orientation" and a "second orientation" to include a 180 degree rotation of the insert. The symmetry of the inserts is dependent upon the apertures therein for accessing the electrical outlet or service device. Claim 5 of the '135 patent, dependent on claim 1, includes the limitation "wherein the insert has an aperture that is substantially rectangular." A rectangle is a shape with symmetry. Therefore, claim 5 appears to preclude Lamson's argument, as some of its single gang units appear to have inserts with a rectangular aperture. The court finds questions of material fact exist as to whether the symmetry element of the inserts found in the Lamson single gang units is identical or equivalent with respect to the multiple orientation element of claims 1 and 12 of the '135 patent. The court leaves the issue of infringement concerning inserts with symmetrical configurations to the trier of fact.

CONCLUSION

For the reasons stated above, Lamson's motion for summary judgment on the issue of non infringement is granted with regard to literal infringement and denied with regard to infringement under the doctrine of equivalents.

/s/
PHILIP G. REINHARD, JUDGE
UNITED STATES DISTRICT COURT

DATED: March 30, 1999

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED,	)	
Plaintiff,	)	No. 94 C 50295
v.	)	
LAMSON & SESSIONS CO.,	)	
Defendant.	)	

MEMORANDUM OPINION AND ORDER

On January 27, 1999, the court held a hearing pursuant to *Markman v. Westview Instruments Inc.*, 517 U.S. 370 (1996), to resolve the matter of interpreting the disputed claim language in claims 1, 12, 14 and 19 of reexamined United States Letters Patent No. B1 5,280,135 ("patent '135"). The court addresses the language at issue as follows:

1. Defendant asserts that claims 1 and 12, which limit the insert to fit or be accommodated "within the aperture" in a "first orientation" and a "second orientation" do not refer to 180 degree rotations of the insert. In construing patent claims, the court should first examine the words of the claims in defining the scope of the invention. *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582 (Fed.Cir. 1996). Here, the claims refer to two separate orientations, without limit to the variety of orientations available. Furthermore, dependent claims 3, 16 and 17 limit the orientations of claims 1 and 12, respectively, to vertical and horizontal orientations. The doctrine of claim

interpretation creates a presumption that the use of different words or phrases in separate claims, where the absence of such differences would make the claims superfluous, makes the differences between such claims significant. *Tandon Corp. v. U.S. International Trade Comm'n*, 831 F.2d 1017, 1023 (Fed.Cir. 1987). In addition, the specification must be reviewed to determine whether any terms have beer used in a manner inconsistent with their ordinary meaning. *See Vitronics Corp.*, 90 F.3d at 1582. The specification supports the construction of "first orientation" and "second orientation" to include multiple orientations, not limited to two orientations 90 degrees apart, and describes the insert capable of being "positioned in a plurality of orientations," (Col. 6, lines 23 24) or " fitted in the aperture... in at least two orientations, 90 degrees apart." (Col. 6, lines 34 35). Therefore, the court finds that the claim language and specification support "first orientation" and second orientation" to include orientations 180 degrees separate from one another.

2. As additional support that patent '135 does not encompass the 180 degree rotation, defendant argues that the language "of sufficient size" pertaining to the size of both the aperture and insert requires the aperture to be larger than the aperture of a single gang cover in order to encompass two different rotational positions of an electrical outlet. The plain meaning of the claim language in dispute does not support such a contention. The court has interpreted the rotational positions defined by the "first orientation" and "second orientation" to include 180 degree rotations of the insert, which would not necessarily require a larger aperture or insert. Furthermore, notwithstanding the court's above findings concerning the orientational limitations, defendant's argument contemplates that the claims are limited to a single gang outlet, rather than an

array of electrical outlets. Claims 1 and 12 refer generically to electrical outlets, rather than single gang outlets. The specification explicitly refers to double gang outlets (col. 8, line 5) as a further embodiment of the invention. A double gang outlet would not necessarily require a larger aperture to encompass either 90 or 180 degree rotations, as counsel for Lamson admitted during the Markman hearing. (Tr. 64) Therefore, the court finds that the claim language "of sufficient size" does not mean "larger."

3. Plaintiff asserts that the "aperture" of claims 1, 12 and 14 includes a recess. Words within a claim are generally given their ordinary and customary meaning, unless the patentee chooses to be his own lexicographer. *See Vitronics*, 90 F.3d at 1582. Where the patentee chooses a special definition, however, that definition must be clearly stated in either the patent specification or file history. *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1578 (Fed. Cir. 1996). A review of the specification and file history shows that the patentee did not assign a special definition for "aperture." Claims 1 and 12 refer to the aperture as being "of sufficient size to accommodate the electrical outlet" in various orientations. This description suggests that the patentee contemplated the aperture as being the hole through which the electrical outlet could be accessed. The specification describes the aperture as having a recess "located along the periphery of the aperture" and assigns separate reference numbers to each of these features. Furthermore, in defining the aperture by reference to the drawings, the specification states, "[t]he aperture 26 has a generally octagonal shape in this embodiment," (Col. 3, lines 21-22), referring specifically to Figures 2-4. Of that set of figures, Figure 4 is the sole drawing which refers to the aperture (26) and the recess (40). The hole through which the electrical outlet or service device would be accessed is

octagonal in Figure 4. The recess surrounding the hole is not octagonal. A review of the claim language and specification leads to the inescapable conclusion that the aperture does not include the recess.

4. Having defined "aperture" above, the court must also construe the meaning of insert as asserted in patent '135. Defendant asserts that the limitation in claims 1 18 requiring the insert be adapted to fit or accommodated "within the aperture" restricts the types of inserts to those with outer dimensions conforming to or smaller than the aperture's outer edge. (Lamson Markman Brief, p. 23). The words of the claims limit the scope of the insert to "within the aperture." The specification describes the preferred embodiment of the insert as follows:

> The insert 14 has a top edge 42, a bottom edge 44 and two side walls 46 and 48. A flange 50 extends around the periphery of the insert 14. The flange 50 is sized and adapted to fit securely within the recess of the base plate 12 in order to form a connection with the base plate 12. A raised ledge 51 is located on the face of the insert 14 around the periphery of the aperture 26 and flange 50.

(Col. 4, lines 5-12) The court construes the above language to describe an insert, separate from, but connected to a flange and a raised ledge. The size of the flange and raised ledge should therefore not be taken into consideration when ascertaining the size of the insert. The notice function of the patent is sufficiently served, by reference to the specification and the drawings, to inform the public that the insert, required by the claims to be "within the aperture" does not include the flange and raised ledge described therein which

clearly do not fit "within the aperture." The flange and the raised ledge are limitations in the specification that were not and should not be imported into the claim language. While it is proper to use the specification to interpret the meanings of words and phrases in the claims, it is improper to import extraneous limitations from the specification into the claims. "By 'extraneous,' we mean a limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases." *E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988). None of the claims in Patent '135 require the insert to be limited in scope by connection to a flange or a raised ledge. The claims, do, however, specifically require that the insert fit "within the aperture." In order to accomplish this, the insert must have an outer dimension conforming to, or smaller than, the outer dimensions of the aperture to fit ***within*** the aperture. Therefore, this court finds that the insert as described in the claims must have an outer dimension conforming to or smaller than the outer dimensions of the aperture, and does not include the flange and the raised ledge so as to fit "within the aperture."

5. Plaintiff asserts that the amendments made to claim 14 during reexamination resulted in a claim "identical" to the original claim 14 within the meaning of 35 U.S.C. § 252. Specifically, plaintiff contends that the original claim language "mounted in" is substantially identical to the reexamined claim language "within the aperture." The court finds that the amended claim 14 is substantively different from the original claim 14 within the meaning of 35 U.S.C. § 252. The Supreme Court recently established a rule of patent law whereby claim amendments are presumed to have been necessitated by the prior art unless the record clearly indicates otherwise and the burden is placed on the

patent holder to show that the amendments made during patent prosecution were for reasons other than limiting the element to avoid prior art. *Warner Jenkinson Company Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, ___, 117 S. Ct. 1040, 1051 (1997). Here, the examiner required that the language of the original claim 14 be changed to avoid prior art. The examiner's finding of patentability with regard to amended claim 14 was specifically "because of the limitation of the insert being adapted to be accommodated within the aperture of the base." (Reex. Exh. 23) Plaintiff has failed to overcome the presumption that the changes were made for any reason other than that the modification of the language to include this limitation was necessary for patentability.

6. Plaintiff contends that the "release button" of the latching mechanism of claim 19 exists only to ease the movement of the biased pin, and is not essential to such movement, nor is it essential to opening the housing. The court holds that claim 19, as supported by the specification, requires that depression of the release button is essential to opening the latching mechanism. The latching mechanism is comprised of a slotted member, a biased pin and a release button. The function of the latching mechanism in claim 19 is "releasably fixing the housing in a closed position with respect to the base so that access to the service device is prevented." (Col. 10, lines 47-49). The claim language describes the release button as "associated with the biased pin and adapted to facilitate moving the pin in opposition to the biasing to locate the biased pin out of the slotted member." (Col. 10, lines 58-61). The biased pin serves to "secure the housing and the base together when the biased pin is located in the slotted member." (Col. 10, lines 55-58). The specification clearly describes the function of the release button in relation to the latching mechanism. "In order to open the housing 16, the release button 144 is pressed in an

upward direction. This bends the flexible tab 142 upwardly removing the pin 140 from the slot 136. Then the housing 16 can be lifted." (Col. 7, lines 36-39). The specification also describes the latching mechanism as "positively closed and will not tend to open unintentionally or accidentally, for example, by someone inadvertently pulling on the appliance cord." (Col. 7, lines 29-32). The court finds that the language of claim 19 as supported shows that the release button is essential to opening the housing.

CONCLUSION

For the reason stated herein, this constitutes the court's findings of fact and conclusions of law.

ENTER:

/s/
PHILIP G. REINHARD, JUDGE
UNITED STATES DISTRICT COURT

DATED: February 9, 1999